

18. (Once Amended) A gaming machine, comprising:
means for conducting a game including random selection of a game outcome; and
a dispenser for dispensing a sweepstakes entry in response to predetermined criteria.

REMARKS

Claims 1-26 are pending in the application. Claims 1 and 18 have been amended to clarify that the game conducted on the gaming machine involves “random selection of a game outcome.”

Claims 1-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams ‘098 in view of Schneider ‘976 and Small ‘730. The Office Action acknowledges that Adams and Schneider “do not disclose dispensing a sweepstakes entry from a gaming machine” but, nonetheless, alleges that “[i]t would have been obvious to one of ordinary skill in the art...to modify Adams [to dispense] a sweepstakes entry from the gaming machine in response to a predetermined criteria as taught by Small.” The applicant respectfully disagrees.

a. Small is nonanalogous prior art

To rely on a reference under 35 U.S.C. § 103, it must be analogous prior art. To be analogous prior art, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem. While PTO classification is some evidence of analogy, similarities and differences in structure and function carry far greater weight. *See* MPEP § 2141.01(a).

The applicant respectfully submits that Small is nonanalogous prior art. The attached Declaration of Shridhar P. Joshi, the named inventor in the present application, supports this conclusion. Mr. Joshi has over ten years of combined engineering and market research experience in the gaming industry. *See Joshi Decl.* ¶ 2.

First, Small is in a different field from that of the applicant's endeavor. *See Joshi Decl.* ¶ 5. Although both Small and applicant's invention involve sweepstakes, the context of Small is vastly different from the context of the applicant's invention. Small relates to automated teller machines (ATMs) and point-of-sale (POS) terminals and a sweepstake-type game for stimulating use of these terminals. The game is incidental to the primary use of the terminals for performing financial transactions. "It is the purpose of the present invention [in Small] to stimulate use of the ATMs and POS terminals by providing a sweepstakes-type game which utilizes a network apparatus." Col. 3, lines 30-33. In contrast, the applicant's invention relates to gaming machines, such as slot machines, whose primary use is to conduct a game involving random selection of a game outcome. The game may, for example, be slots, poker, keno, bingo, or blackjack. This is a distinctly different field from Small's field of ATMs and POS terminals.

Second, Small is not reasonably pertinent to the problem with which the inventor was concerned, because Small logically would not have commended itself to an inventor's attention in considering applicant's objective of making gaming machines more exciting and entertaining. *See Joshi Decl.* ¶ 6. The applicant's invention encourages the use of gaming machines. The applicant did not look to, and does not believe an ordinary artisan would look to, the field of ATMs or POS terminals in considering his objective.

Accordingly, Small is nonanalogous prior art and, therefore, cannot be considered in an obviousness rejection. Because the Office Action relies upon Small for the claimed element of

dispensing a sweepstakes entry from a gaming machine, the applicant respectfully submits that the obviousness rejection based on Adams, Schneider, and Small should be withdrawn.

b. Even if Small is considered analogous art (which it is not), the combination of Adams, Schneider, and Small fails to teach or suggest the claimed invention

The claimed invention requires that a sweepstakes entry is dispensed from a gaming machine in response to predetermined criteria. Method claims 1-17, for example, include a step of “dispensing a sweepstakes entry from the gaming machine in response to predetermined criteria.” Apparatus claims 18-26 include “a dispenser for dispensing a sweepstakes entry in response to predetermined criteria.”

It is advantageous to dispense a sweepstakes entry from a gaming machine for several reasons. First, this automated process is less labor intensive and easier to track and audit than such alternatives as calling a casino floor attendant to manually hand out a sweepstakes entry to a player at the gaming machine. Second, because the dispensed sweepstakes entry is more tangible than such alternatives as electronically entering a player into a sweepstakes, the player may feel more confident and satisfied that he or she is truly entered into a sweepstakes once the entry is submitted to a sweepstakes provider. Third, the dispensed sweepstakes entry may be used by a sweepstakes provider, such as a casino, to create a large social event (e.g., a drawing) that attracts players back to the casino.

The Office Action acknowledges that Adams and Schneider “do not disclose dispensing a sweepstakes entry from a gaming machine” and relies upon Small for such disclosure. This reliance on Small, however, is misplaced. Small does not teach or suggest the claimed element of dispensing a sweepstakes entry from a machine.

Briefly, Small operates as follows. Small is designed to be used in conjunction with a network of financial institutions having interconnected data processing facilities. Col. 2, lines 59-61. Typically, each financial institution has a plurality of ATM and/or POS terminals. Col. 2, lines 61-63. Upon a user's insertion of a debit card into an ATM or POS terminal and entry of a valid PIN, a remote sweepstakes computer on the network reads the user's financial account number or other selected user indicia and compares the account number to a computer-generated prize number. Col. 3, lines 33-39. The user is notified of the results of the sweepstakes by means of a printed receipt. Col. 8, lines 44-45. If a winning correlation exists between the two numbers, the sweepstakes computer determines a prize to be awarded to the user. Col. 3, lines 61-63. If cash awards are given, the operator of the sweepstakes may instantaneously credit the user's account or, in the case of an ATM, immediately deliver cash to the user. Col. 4, lines 10-14. If the award is not given immediately at the ATM, the transaction receipt is printed to indicate the award to the user. Col. 4, lines 15-17.

Contrary to the claimed invention, the ATM or POS terminal in Small does not dispense a sweepstakes entry to the user for subsequent submission to a sweepstakes provider. In fact, the only item dispensed to the user is a printed receipt notifying the user of the results of the sweepstakes, which is conducted by the sweepstakes computer while the user performs a financial transaction at the ATM or POS terminal. The printed receipt is not a sweepstakes entry. Nowhere does Small contemplate dispensing a sweepstakes entry to a user of the ATM or POS terminal. If Small were modified to dispense a sweepstakes entry instead of sweepstakes results, Small's principle of operation would be changed. *See MPEP § 2143.01 ("The proposed modification cannot change the principle of operation of a reference.")*. Such modification is, therefore, not permissible.

Because the combination of Adams, Schneider, and Small fails to teach or suggest a fundamental element of the claimed invention, the applicant respectfully submits that the obviousness rejection based on these references should be withdrawn.

It is the applicants' belief that all of the claims are now in condition for allowance, and action towards that end is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

Date: March 6, 2002



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